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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,794	08/03/2001	Christoph Wagener	4121-124	9609

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INTELLECTUAL PROPERTY / TECHNOLOGY LAW

PO BOX 14329

RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

HELMS, LARRY RONALD

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,794

Applicant(s)

WAGENER ET AL.

Examiner

Larry R. Helms

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) 5, 7, 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/ISB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-2, 8 have been amended.
2. Claims 5, 7, 9 and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions. Election was made in Paper No. 7.
3. Claims 1, 2, 6, and 8 are under examination.
4. It is acknowledged that the method claims 9-10 will be rejoined upon allowance of the composition claims under MPEP 821.04.
5. The text of those sections of Title 35 U.S.C. code not included in this office action can be found in a prior Office Action.

Response to Arguments

6. The rejection of claims 1, 2, 6, and 8 under 35 U.S.C. 102(b) as being anticipated by Drzeniek et al (Cancer Letters 56:173-79, 1991) as evidenced from the specification is maintained.

The response filed 1/28/05 has been carefully considered but is deemed not to be persuasive. The response states that the examiner has indicated that the claims are enabled due to the completion of the deposit for the hybridoma and antibody and the references do not describe the claimed invention sufficiently to place it in possession of a person of ordinary skill in the field and the same lack of enablement that the Office rejected the claims before the deposit was fulfilled is applied to the references because

the antibodies cannot be reproduced from the description of the references and the Office cannot have it both ways (see pages 6-8 of the response). In response to this argument, while it is true that the deposit does enable the claimed antibodies, the references are presumed to also be enabled because there is no evidence of record that the antibodies in the references (which are admitted to be the same as those claimed (see page 2 paragraph 007)) were not public ally available. The references list several persons in addition to the one inventor (Wagener) and it is assumed the antibodies were public ally available to other labs.

The response further states inherency cannot be established by probabilities or possibilities and the references are completely silent on using the claimed antibodies for reducing angiogenesis (see page 9 of response). In response to this argument, as stated in the rejection the antibodies in the prior art are the same as those in the specification and claimed and as such the product would have the identical properties of the claimed antibodies whether or not they are disclosed in the reference.

There is no structural difference between the claimed antibody and the prior art antibody because as admitted in the specification they are the same (see rejection).

7. The rejection of claims 1, 2, 6, 8 under 35 U.S.C. 102(b) as being anticipated by Prall et al (The Journal of Histochemistry and Cytochemistry 44:35-41, 1996) is maintained.

The response filed 1/28/05 has been carefully considered but is deemed not to be persuasive. The response states that the examiner has indicated that the claims are enabled due to the completion of the deposit for the hybridoma and antibody and the references do not describe the claimed invention sufficiently to place it in possession of a person of ordinary skill in the field and the same lack of enablement that the Office rejected the claims before the deposit was fulfilled is applied to the references because the antibodies cannot be reproduced from the description of the references and the Office cannot have it both ways (see pages 6-8 of the response). In response to this argument, while it is true that the deposit does enable the claimed antibodies, the references are presumed to also be enabled because there is no evidence of record that the antibodies in the references (which are admitted to be the same as those claimed (see page 2 paragraph 007)) were not public ally available. The references list several persons in addition to the one inventor (Wagener) and it is assumed the antibodies were public ally available to other labs.

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There is no structural difference between the claimed antibody and the prior art antibody because as admitted in the specification they are the same (see rejection).

Conclusion

8. No claim is allowed.
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (571) 272-0832. The examiner can normally be reached on Monday through Friday from 7:00 am to 4:30 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at (571) 272-0787.

Art Unit: 1642

11. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center telephone number is 571-273-8300.

Respectively,

Larry R. Helms

571-272-083



LARRY R. HELMS, PH.D
PRIMARY EXAMINER